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| APPLICATION NO.               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 10/797,937                    | 03/11/2004  | Avinoam Rubinstain   | 068758.0179         | 4875             |
| 51092                         | 7590        | 03/20/2008           |                     |                  |
| ESCHWEILER & ASSOCIATES LLC   |             |                      |                     | EXAMINER         |
| 629 EUCLID AVENUE, SUITE 1000 |             |                      |                     | KING, JAMAL J    |
| NATIONAL CITY BUILDING        |             |                      | ART UNIT            | PAPER NUMBER     |
| CLEVELAND, OH 44114           |             |                      | 4141                |                  |
|                               |             |                      |                     |                  |
|                               |             |                      | NOTIFICATION DATE   | DELIVERY MODE    |
|                               |             |                      | 03/20/2008          | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing@eschweilerlaw.com

|                              |                                      |  |
|------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/797,937 | <b>Applicant(s)</b><br>RUBINSTAIN ET AL. |
|                              | <b>Examiner</b><br>JAMAL J. KING     | <b>Art Unit</b><br>4141                  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 3/11/2004.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-18 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 11 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date 3/11/2004

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-19 are pending.

***Information Disclosure Statement***

2. The Applicant's Information Disclosure Statement, filed on 3/11/2004 has been received and entered into record. Therefore, the examiner has considered the cited references.

***Specification***

3. The disclosure is objected to because of the following informalities: In the Abstract, lines 5 & 9-10 mention "DSL". All terms should be spelled out in order to produce clear and concise understanding of the disclosure.

Correction is required.

In the specification page 17, paragraph [0058] line 20 mentions the element 184 as "module", and page 17, paragraph [0058] line 20 mentions the element 184 as "message memory unit".

Appropriate correction is required.

In the specification page 17, paragraph [0057] line 12 mentions the element 187 as "100Base TX module", and page 18, paragraph [0059] line 5 mentions the element 182 as "100BaseTX port".

Appropriate correction is required.

In the specification page 25, paragraph [0083] line 27 mentions the element 89 as "header generator", and page 26, paragraph [0083] line 1 mentions the element 89 as "frame formatter".

Appropriate correction is required.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-23 & 26 of copending Application No. 09/322062. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations in the instant application and the copending application are similar in scope. The limitations only show differences with the choice of words that are used in the claims. Therefore, the claims in the instant application are obvious over the copending application's claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 18 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24-25 & 27-28 of copending

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Application No. 09/322062. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations in the instant application and the copending application are similar in scope. The limitations only show differences with the choice of words that are used in the claims. Therefore, the claims in the instant application are obvious over the copending application's claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3, 5, 7-8, 10, 14-17 & 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims recite “DSL”. All terms must be spelled out in order to present a clear and concise understanding.

10. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims recite “MIP”. All terms must be spelled out in order to present a clear and concise understanding.

9. Claims 17 & 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claim recites “N telephone lines”, “N downstream transmission paths” and “N upstream transmission paths”. All terms must be spelled out in order to present a clear and concise understanding.

***Allowable Subject Matter***

10. Claims 1-19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, and double patenting issues set forth in this Office action.

***Reason for Allowance***

11. The following is an examiner’s statement of reasons for allowance:

The cited prior art taken alone or in combination fail to teach, in combination with other claimed limitations a modem, a point to point facility transport system and a facility transport system for symmetric bi-directional transporting of an Ethernet signal over a configurable number of telephone lines, specifically receiving and transmitting a single Ethernet signal from ports connected to a physical layer module and coupled to a data splitter so the received Ethernet signal is split by a data splitter into downstream data signals where downstream and upstream transmission paths transport the single Ethernet signals with data rates and a data collection and reorganization unit assembles the upstream DSL signals into a single Ethernet signal for transmission by the physical layer module, as recited in the independent claims 1, 17 and 19.

The closest prior art Lewin (U.S. Patent No. 6,829,252) discloses a modem, a point to point facility transport system and a facility transport system for symmetric bi-directional transporting of an Ethernet signal over a configurable number of telephone lines, specifically receiving and transmitting a single Ethernet signal from ports

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connected to a physical layer module and coupled to a data splitter so the received Ethernet signal is split by a data splitter into downstream data signals where downstream and upstream transmission paths transport the single Ethernet signals with data rates.

However, Lewin does not disclose the above stated limitations in combination with the data collection and reorganization unit which assembles the upstream DSL signals into a single Ethernet signal for transmission by the physical layer module, as recited in the independent claims.

***Conclusion***

12 TITLE: Infineon, 3Com Patent Ethernet-over-DSL-Company Business and Marketing.

TITLE: Ethernet- The Next Generation WAN Transport Technology.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMAL J. KING whose telephone number is (571)270-3160. The examiner can normally be reached on Monday - Thursday 6:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chameli Das can be reached on 571-272-3696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jamal King

Patent Examiner

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March 12, 2008

/CHAMELI C. DAS/  
Supervisory Patent Examiner, Art Unit 4141